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OFFICE OF PETITIONS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

PATENT APPLICATION

DAC

In re application of

Docket No: Q62906

Eiichi KITAZONO, et al.

Appln. No.: 09/744,684

Group Art Unit: 1713

Confirmation No.: 3250

Examiner: Robert D. Harlan

Filed: January 29, 2001

For: ADHESIVE AGENT COMPOSITION, AND PERMEABLE ADHESIVE TAPE,
ADHESIVE DRUG COMPOSITION AND ADHESIVE TAPE PREPARATION
CONTAINING THE ADHESIVE AGENT COMPOSITION

**PETITION TO WITHDRAW FINALITY
UNDER 37 C.F.R. § 1.181**

ATTN: Technology Director
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition to withdraw the finality of the Office Action dated November 17, 2003.

This petition is being filed prior to two months after the action complained of, and therefore, is timely (37 C.F.R. § 1.181((f)).

Pursuant to 37 C.F.R. § 1.17(h), submitted herewith is a check in the amount of \$130.00 for filing a petition under 37 C.F.R. § 1.182.

Action Requested

Applicants submit that the final Office Action dated November 17, 2003, improperly has been made final, and thus, respectfully solicit withdrawal of the finality of the Office Action.

Statement of Facts Involved

- 1) A first Office Action was mailed March 11, 2003.
- 2) In the first Office Action, claims 1-5 and 8-15 [sic, 18] were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of JP Publication No. 09-143062, JP Publication No. 04-266742, International Publication No. WO 92/10154 and JP Publication No. 01-233212.
- 3) Based upon receipt of a search report in a corresponding foreign application, Applicants filed an Information Disclosure Statement (IDS) with fee on May 7, 2001.
- 4) Two of the references (JP Publication No. 09-143062 and WO 92/10154), cited in the foreign search report, were relied upon by the Examiner in making the rejection in the first Office Action.
- 5) On August 17, 2003, Applicants replied to the first Office Action without amending any claims.
- 6) On November 17, 2003, a second Office Action was mailed.
- 7) The Examiner designated the second Office Action as final, stating that it was based on submission of the IDS with fee.
- 8) In the second Office Action, claims 1-5 and 8-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over the combination of previously cited JP Publication No. 09-143062 and previously cited Ebert et al. (WO 92/10154).
- 9) This petition followed.

Point or Points to be Reviewed

The undersigned requests review of whether the new ground of rejection was necessitated by the submission of the Information Disclosure Statement (IDS) with fee filed on May 7, 2001, or by any other valid reason for making an Office Action final.

Argument

In the final Office Action, the Examiner introduces a new ground of rejection and states that the new ground is based upon the submission of an IDS filed during the period set forth in 37 C.F.R. § 1.97(c) with the fee set forth in 37 C.F.R. § 1.17(p). However, the undersigned respectfully submits that the Examiner's reliance upon the submission of the IDS is one of form not substance. Furthermore, the Examiner has violated the mandate of the MPEP, that before final rejection is in order, a clear issue should be developed.

The MPEP contemplates that a second or subsequent action be made final where the new ground of rejection is necessitated by the IDS (See MPEP 706.07(b), form paragraph 7.40.01, which is entitled "Action Is Final, Necessitated by IDS with Fee").

Furthermore, the MPEP directs the Examiner to develop a clear issue before final rejection by fully applying the references in the first Office Action. The MPEP § 706.07 states:

Before final rejection is in order, a clear issue should be developed between the examiner and applicant to bring the prosecution to as speedy conclusion as possible and at the same time to deal justly with both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and

the references fully applied;....switching from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat obtaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection. [emphasis added]

In the present case, the Examiner has done just what the MPEP prohibits.

The references cited in the IDS and relied upon by the Examiner in the final Office Action, were cited and relied upon by the Examiner in the first Office Action. Clearly, the IDS revealed nothing that necessitated the new ground of rejection. The references had already been cited by the Examiner in a first rejection.

Furthermore, there is no other valid ground to make the rejection final. The claims were not amended in the response to the first Office Action. Therefore, no amendments necessitated the new grounds of rejection. In the first Office Action, the Examiner could and should have made the rejection he is now making in the final Office Action.

By not making both rejections in the first Office Action, the Examiner violated the provisions of the MPEP that mandate that the Examiner fully apply the references that were before him prior to issuing the first Office Action. Rather, the Examiner switched from one set of references to another, rejecting, in successive actions, exactly the same subject matter, as prohibited by the MPEP. Further, the rejection in the final Office Action was over a subset of the references applied in the rejection in the first Office Action. Clearly, since both references cited in the final Office Action were cited by the Examiner in the first Office Action, the

Examiner could have and should have set forth the new grounds of rejection in the first Office Action, rather than waiting until the next Office Action.

In summary, since the Examiner introduced a new ground of rejection that was neither necessitated by information submitted in an IDS with fee filed nor by Applicants' amendments of the claims (since the claims were not amended), the undersigned respectfully submits that it was improper to designate the outstanding office action as a final rejection.

For the reasons discussed above, Applicant requests that the finality of the Office Action be withdrawn.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

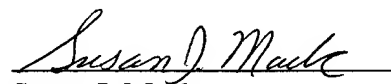
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CUSTOMER NUMBER

Date: January 15, 2004


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